

REMARKS

Status of the Claims

Claims 1-6, 10, 11, 14-17, 21, 23-24, and 34-39 were canceled, and upon entry of this amendment, Claims 7-9 will be canceled.

Claims 12 and 13 are not currently under any rejection. However, in the section labeled "Status of the Claims," the Examiner has stated that the claims stand rejected. Applicants request that the Examiner clarify the status of these claims.

The Examiner has found Claims 18-20 and 22 allowable.

Claims 25-32 are withdrawn.

Claims 33 and 40 stand rejected.

Claims 41-57 are new. New Claim 41 is directed to pharmaceutical compositions. New Claims 42-57 are directed to methods of use of the claimed compounds and are withdrawn.

Claim Amendments

Applicants have canceled Claims 7-9.

Claims 12 and 13 have been amended to put them in independent form.

Claims 12, 13, 18-20 and 22 have been amended to replace the phrase "such as" with the phrase "independently selected from the group consisting of". In addition, Applicants have added "alkyl" to the list of substituents for R⁶. Support for this amendment to Claim 12 can be found on page 17, lines 1-2 of the specification. Support for this amendment to Claim 13 can be found on page 17, lines 16-17 of the specification. Support for this amendment to Claims 18-20 can be found on page 20, lines 22-23 of the specification. Support for this amendment to Claim 22 can be found on page 23, lines 6-7.

Claim 33 which is directed to pharmaceutical compositions has been amended to depend from Claim 12 and new pharmaceutical composition Claim 41 which depends from Claim 13 has been added.

Withdrawn method Claims 25-32 have been amended to depend from Claim 18; new method Claims 42-49 which depend from Claim 12 have been added; and new method Claims 50-57 which depend from Claim 13 have been added. Method Claim 30 which is directed to a method of treatment that comprises administering a combination has been amended to independent form.

In addition, method Claims 25, 26, and 28-32 and pharmaceutical composition Claims 33 and 40 have been amended to include pharmaceutically acceptable salts. Support for this amendment can be found on page 24, last paragraph to page 25, first paragraph of the specification.

No new matter has been added.

Rejection of Claims 7, 8, 33, and 40 Under 35 U.S.C. § 102(b) Over WO94/01113

The Examiner has rejected Claims 7, 8, 33, and 40 under 35 U.S.C. § 102(b) over Ogawa, *et al.* WO94/01113 (hereinafter "Ogawa") stating that it clearly discloses compounds and pharmaceutical compositions of Formula (Ia) and points to compound 2-19 on page 146 of the reference.

Claims 7 and 8 have been canceled rendering the rejection moot for these claims.

Pharmaceutical composition Claim 33, as amended, depends from Claim 12 and thus includes all of the limitations of the compounds of Claim 12. The compounds of Claim 12 differ from the compounds of Ogawa at least because they have a naphthyl center ring instead of a phenyl center ring. Thus, Claim 33 is novel over Ogawa.

Pharmaceutical composition Claim 40 depends from Claim 18 and thus includes all of the limitations of the compounds of Claim 18. The compounds of Claim 18 differ from the compounds of Ogawa at least because they have a decahydroisoquinoliner system instead of a decahydroquinoline ring system. Therefore, Claim 40 is novel over Ogawa.

New pharmaceutical composition Claim 41 which depends from Claim 13 is also novel over Ogawa. The compounds of Claim 13 differ from the compounds of Ogawa at least because they have a naphthyl center ring instead of a phenyl center ring.

Since Claim 33, as amended, and Claim 40 are novel over Ogawa, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Rejection of Claims 7, 8, 9, 33, and 40 Under 35 U.S.C. § 103(a) Over WO94/01113

The Examiner has rejected Claims 7, 8, 9, 33, and 40 under 35 U.S.C. § 103(a) over Ogawa *et al.*, WO94/01113 (hereinafter "Ogawa"). Although Applicants disagree with the Examiner's assessment, in order to expedite prosecution Claims 7, 8, and 9 have been canceled.

Claim 40 is directed to pharmaceutical compositions which comprise compounds of Claim 18, or their pharmaceutically acceptable salts. The Examiner has found Claim 18 to be allowable, and thus, non-obvious in view of Ogawa. Therefore, the pharmaceutical compositions of Claim 40 which include all of the limitations of Claim 18 are non-obvious in view of Ogawa.

Claim 33, as amended, is directed to pharmaceutical compositions which comprise compounds of Claim 12, or their pharmaceutically acceptable salts. The Examiner has not found Claim 12 obvious in view of Ogawa. Therefore, the pharmaceutical compositions of Claim 33 which include all of the limitations of Claim 12 are non-obvious in view of Ogawa.

Since Claim 33, as amended, and Claim 40, are non-obvious in view of Ogawa, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Restriction Requirement

The Examiner has required that Applicants amend the claims to the elected Group.

Applicants elected Group I of the restriction requirement issued in the Office Action mailed on December 5, 2007. Group I was drawn to compounds and pharmaceutical compositions of Formulas (Ia), (Ih) and (Ii) wherein X and Y are carbon (phenyl or naphthyl with no additional fused rings), and R₃ and R₄ form a hydroquinoline. It is evident that the Examiner intends to include hydroisoquinoline in the definition of R₃ and R₄ since he includes Formula (Ih) and (Ii) in Group I in which R₃ and R₄ form an hydroisoquinoline.

The compounds claimed in the currently pending claims all have a phenyl or naphthyl ring with no other fused rings and R₃ and R₄ form a hydroquinoline or hydroisoquinoline ring. The structural formula in Claim 12 is formula (Ib) instead of Formulas (Ia), (Ih) and (Ii), but formula (Ib) is a subset of formula (Ia) in which R₁ and R₂ combined together with the carbon atoms to which they are attached form an optionally substituted aromatic 6-membered ring (see page 13, line 13 to page 14 line 15 of the specification, in particular page 13, lines 17-18).

Likewise, the structural formula in Claim 13 is formula (Ic) instead of Formulas (Ia), (Ih) and (Ii), but formula (Ic) is a subset of formula (Ia) in which W and R₁ combined together with the carbon atoms to which they are attached to form a 6-membered aromatic ring which is optionally substituted with alkyl, alkoxy, aryl, heteroaryl, halo, -NR₆Z, C(O)NR₆R₇, -OR₈ or -OC(O)NR₆R₇ (see page 13, line 13 to page 14 line 15 of the specification, in particular page 14, lines 8-10).

If the Examiner is asserting that the claims do not comply with the elected Group, Applicants request that the Examiner specifically point out where the claims do not comply.

Rejoinder of Product and Process Claims

Applicants were advised in the Restriction Requirement mailed on December 5, 2007 that once product claims are found allowable, withdrawn process claims that include all of the limitations of the allowed product claims would be considered for rejoinder. Applicants believe that all the outstanding rejections have been addressed and the pending claims are in condition for allowance, therefore Applicants request that withdrawn process Claims 25-32 and 42-57 be rejoined with the product claims.

Conclusion


Applicants have addressed each and every issue set forth by the Examiner. Applicants respectfully submit that the present application is in good condition for allowance and respectfully request consideration and withdrawal of the outstanding rejections.

If the Examiner believes for any reason that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (617) 871-7802.

The Commissioner is hereby authorized to charge payment for a request for Continued Examination as set forth in C.F.R. § 1.17(e), a petition for a three-month extension of time as set forth in C.F.R. § 1.17(a), and any excess claims fees to Deposit Account No. 50-4409. In addition, if necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge any additional payment for any additional fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17 or credit any overpayment to Deposit Account No. 50-4409.

Respectfully submitted,

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